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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,990

07/21/2005

Roland C Santa Ana

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7826

24040

7590

09/17/2009

DENNIS G. LAPOINTE

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EXAMINER

GRANT, ALVIN J

ART UNIT

PAPER NUMBER

3723

NOTIFICATION DATE

DELIVERY MODE

09/17/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/542,990	Applicant(s) SANTA ANA, ROLAND C	
	Examiner ALVIN J. GRANT	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the partially flattened hammerhead bottom side surface side surface; the partially flattened hammerhead left and right side surfaces; and, the means for dampening recoil shock must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 1 is objected to because of the following informalities:
- In line 11, it seems that “said grooves with:’ should read, “said grooves comprising:”.
 - In line 15, it seems that “a nail head of the nail” should read, “the head of the nail”.
 - In line 18, it seems that “at least one groove on least one” should read, “at least one groove on at least one”.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 27-31** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification is silent with regard to “means for dampening recoil shock from the hammerhead”, which is claimed in newly added claim 27.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 27-31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 27, line 18 recites the phrase “or a hammerhead upper side surface”. It is not clear as to whether a different hammerhead is being referred to or it is the same hammerhead.
8. Claim 27, lines 17-19, the phrase “means for dampening.....transversely oriented” is awkwardly and confusingly worded.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 27-29**, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotschner et al. 6,339,974 in view of Te 6,571,666.

Kotschner et al. discloses a hammerhead affixed to a handle with flattened left and right side surfaces and a magnetic core disposed in the head in communication with the nail retention groove. Kotschner et al. does not specifically disclose multiple grooves having partially frustoconical interior portions. Te (Fig. 12) discloses a hammer head having multiple grooves having partially frustoconical interior portions so as to accommodate

Art Unit: 3723

nails having frustoconical heads. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made Kotschner et al.'s hammer head with multiple grooves having partially frustoconical interior portions as taught by Te so as to accommodate nails having frustoconical heads.

11. Claims 30-32, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotschner et al. and Te and in view of Hu 6,283,44 and in further view of Caspall 4,726.

Kotschner et al. as modified is described above. The modified Kotschner et al. does not specifically disclose a pair of flared claws with each claw having a nail removal void. Hu discloses a hammer having a pair of flared claws in which the each claw has a nail removal void so as to facilitate the accommodation of nails of different sizes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the modified Kotschner et al.'s hammer head to have a pair of flared claws in which the each claw has a nail removal void as taught by Hu so as to facilitate the accommodation of nails of different sizes. Additionally, the modified Kotschner et al. does not specifically disclose the top portion of the hammer being rounded laterally. Caspall (best shown in Fig. 2) discloses a hammer in which the head is rounded laterally so as to enhance the maneuverability of the hammer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the modified Kotschner et al.'s hammer head rounded laterally as taught by Caspall so as to enhance the maneuverability of the hammer.

Response to Arguments

12. Applicant's arguments filed 6/29/09 have been fully considered but they are not persuasive.

13. In response to Applicant's arguments that combination of US Patent 6,339,974 (to Kotschner et al.), with US Patents 6,571,666; 4,723,582; and 6,283,449, to Te, Caspell and Hu respectively does not disclose the claimed invention and there is no motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kotschner et al. discloses a hammer head having magnets and flattened side surfaces and has a slot for securing nails therein. Te, Caspell and Hu, considered separately, teach the remaining claimed elements as best understood.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN J. GRANT whose telephone number is (571)272-4484. The examiner can normally be reached on Mon-Fri 8:00-4:30.

Art Unit: 3723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alvin J Grant/
Examiner, Art Unit 3723